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PATENT &amp; TRADEMARK OFFICE

In re application of: D. J. Baillargeon, et al.

U. S. Serial No.: 09/498,793

Filed: February 4, 2000

For: FORMULATED LUBRICANT OILS  
CONTAINING HIGH-PERFORMANCE BASE  
OILS DERIVED FROM HIGHLY PARAFFINIC  
HYDROCARBONS

- ) Before the Examiner  
    ) E. M. McAvoy  
    ) Group Art Unit 1764

) Batch Number

**COMMISSIONER FOR PATENTS**

Washington, D.C. 20231

Sir:

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Transmittal herewith is a Reply Brief in the above-identified application.

Petition for extension of time pursuant to 37 CFR 1.136 and 1.137 is hereby made, if and to the extent, required. The fee for this extension of time is calculated to be \$ 100.00 to extend the time for filing this response until March 23, 2003.

The fee for any changes in number of claims has been calculated as shown below.

CLAIMS AS AMENDED						
(1)	(2) Claims Remaining After Amendment	(3)	(4) Highest Number Previously Paid For	(5) Present Extra	(6)	(7)
Total Claims	*	Minus	**	0	x 18.00	0
Indep. Claims	*	Minus	***	0	x 80.00	0
MULTIPLE DEPENDENT CLAIM FEE					\$270.00	
FEE FOR CLAIM CHANGES						00

\* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

\*\* If the "Higher Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

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The total fee for this \$ -0-, including claim changes and any extension of time is calculated to be \$ 110.00.

03/27/2003 AWONDAF1 00000065 051330 09498793

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The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 and 1.17 which may be required by this paper, or credit any overpayment, to Deposit Account No. 05-1330. A duplicate copy of this Form is enclosed.

24 March 03

Date of Signature

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Applicant(s): D. J. Ballargeon, et al.

Docket No.

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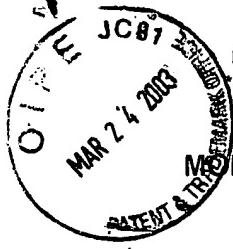
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : D. J. Baillargeon, et al.  
Serial No. : 09/498,793  
Filed : 4 February 2000  
For : FORMULATED LUBRICANT OILS CONTAINING  
HIGH-PERFORMANCE BASE OILS DERIVED FROM  
HIGHLY PARAFFINIC HYDROCARBONS  
Group Art Unit: 1764  
Examiner : E. M. McAvoy

REPLY BRIEF

Assistant Commissioner for Patents  
Washington, D.C. 20231

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This is in reply to the Examiner's Answer (Paper No. 14) of 23 December 2002.

1. Trewella does not deal with the same problem

1.1. The Examiner has reiterated (Paper No. 14, page 5, top) the position that because a preference for certain values of base stock viscosity index and pour point is expressed in the Trewella reference (column 6, lines 1-15), appellant's argument that the combined properties of the finished lubricant, including pour point, viscosity index and biodegradability is not persuasive of patentability<sup>1</sup>. Trewella's expression of preferences has, however, to be set against the technical problem which confronted him and his co-inventors. Trewella's technical objective was to produce lubricant basestocks with superior low temperature performance properties (column 1, II. 11-14; column 3, II. 7-8; column 5 II. 55-67). Trewella's expressed preferences must be set against the background of this objective since consideration of the problem is always relevant to obviousness.

1.2. It is perfectly reasonable to posit that a set of preferences valid with one objective are not necessarily valid if the objective is changed. Trewella itself confirms this point

<sup>1</sup> It is assumed that this argument is made with respect to the claims as a whole since it is not explicitly referred to any one group of claims.

when, in column 5, lines 59-67, it is stated that conventionally, lowering pour point results in decreased viscosity index. Thus, it would have been quite valid for a lubricant formulator prior to Trewella to express a preference for low pour point but, at the same time, that same person, if appropriately skilled, would not have expected a high viscosity index to go with it. The preference for low pour point would therefore be valid when low temperature fluidity was the objective but if, on the other hand, the objective is to secure good all round engine performance, viscosity index would have become significant and, according to conventional expectations could not have been met at the same time as good low temperature viscometrics. The Trewella fluids, however, were later found to have a good combination of pour point and viscosity index (column 6, lines 1-8), thus upsetting the preference established by the prior art. From this it follows than in one context, a preference for low pour point is valid but in another, it is not.

1.3. In the present case, the preference expressed by Trewella is obviously valid for the objective it encompassed, namely of obtaining a lubricant basestock of superior low temperature performance. On the other hand, when the objective is to achieve a finished lubricant which possesses a combination of good low temperature performance coupled with biodegradability, Trewella's preferences, expressed in a different context may become irrelevant.

1.4. What the Examiner has done, in making this point, is to engage in that highly selective, judicious selection of facts thought to be convenient to the rejection without the guidance of the prior art itself and this is not the standard of 35 USC 103. *In re Petering* 301 F. 2d 676, 133 USPQ 275 (CCPA 1962). There is nothing in Trewella which indicates the desirability of combining something less than the lowest pour point (-25° to -55°C) which is contemplated by Trewella with a limit on the VI values, again less than what Trewella achieves, in order to achieve a result of which nothing is spoken by the prior art and towards which the prior art provides no signposts. It is the underlying problem which gives the context in which the invention is made and against which the obviousness of the invention must be assessed. *In re Sponnoble* 405 F.2d. 578, 585 (CCPA 1969). *Ex parte Wisdom and Hilton* 184 U.S.P.Q. 822 (PO Bd. Apps.).

1.4. Aside from the issue of biodegradability, applicants have shown other advantages which are unexpected. As was pointed out in Section 10 of the Appeal

Brief, the careful selection of basestock parameters results in superior low temperature viscosmetrics for the finished lubricant. To be specific, the use of a basestock with a pour point of -40°C results in a finished lubricant with a pour point which is lower (superior) to that obtained with a basestock with a pour point of -66°C. This provides direct evidentiary support for Claim Group 3 covering claim 10 which reads right on the basestock pour point of -40°C. Further, the showing mentioned in Section 10.1.3 of the Appeal Brief provides even better evidentiary support for Claim Group 3 (Claim 10). That there is a definite limited range of basestock pour points over which superior lubricant low temperature viscometrics are obtained is shown by Table 10 in the specification and Trewella provides no signposts in this direction, that is, of stopping short of the lowest achievable pour points if the objective is to produce a finished lubricant which is both biodegradable as well as of improve performance.

**2. There is no substantial evidence of record which shows that Trewella inherently possessed the specified biodegradability**

2.1. The entire vice of the Examiner's position is exposed by the statement appearing for the first time on page 6 of Paper No. 14:

"Although the property of biodegradability is not set forth, the examiner maintains the position that since the paraffinic basestock of the prior art *may* be the same as appellants' paraffinic basestock, the degree of biodegradability *may* and most likely is the same". (Emphasis added).

2.2. The use of the permissive confirms that what the Examiner is saying is that Trewella's teaching broadly encompasses the basestocks used as a component in the presently claimed lubricants – which is not merely true but admitted to be so (specification, page 10, lines 1-3). But this does not a proper rejection make. Encompassing does not constitute obviousness. *In re Benno* 226 USPQ 683 (Fed. Cir. 1985). The fact that an invention may fall within the broad scope of the prior art, whether set out in a claim or the corresponding supporting description does not negate patentability. What is required is to do this is that the prior art in and of itself should point unequivocally at the claimed invention.

The Examiner's hesitancy in making a definite assertion that the Trewella fluids are the same as those now being claimed is persistent – see Paper No. 14, pages 6, 8 and 9. If inherency in the prior art is to be the basis of a rejection, the inherency must be inevitable, not merely the balance of probabilities or possibilities. *In re Oelrich and Divigard* 21 USPQ 323, 326 (CCPA1981).

### **3      The comparative showing supports patentability**

3.1. The Examiner has added the argument that the showing of unexpected results made by Applicant is not commensurate with the scope of the claims and not sufficient to rebut the asserted case of *prima facie* obviousness (see the passage bridging pages 5 and 6 of Paper No. 14). Even if the Examiner's argument were to be accepted with respect to the broad claims, it has ignored the narrower claims, especially those of Claim Group 3 (Claim 10) which is closely aligned with the results cited in the Brief.

3.2. Claim 10 is directed to the use of basestocks with pour points from  $-30^{\circ}$  to  $-45^{\circ}\text{C}$  which exactly and closely brackets the  $-40^{\circ}\text{C}$  pour point of Example 12 (see Brief Table 1, page 6) and the  $-34^{\circ}\text{C}$  pour point of Example 18 (see Brief Table 2, page 7) for which good results have been established. The Examiner has, it is noted, not sought to assert that what has been observed by the applicants in terms of improved low temperature viscometrics is in any way to be expected by the skilled lubricant formulator; the Board is therefore bound, on the basis of the present record, to hold that the results are, in fact, unexpected: there is no substantial evidence of record showing that the improvements in the pour point of the finished lubricant and the MRV and CCS values would have been expected to the skilled lubricant formulator. The record must be specific and detailed in the evidentiary support for the conclusions made. *In re Lee* 61 USPQ 2d 1430, 1433 (Fed. Cir. 2002), citing *In re Kotzab* 55 USPQ 2d 1313 (Fed. Cir. 200) on the need for specificity.

3.3. The Examiner, in discussing Claim Group 3 (page 8 of Paper No. 14) has argued that the adduced showing is not considered persuasive on the issue of patentability because "other factors may have contributed to the improved results obtained in Table 1 such as the selection and amount of the co-base oil added to the formulation and the selection and amount of the additives", pointing out that the "co-base oil is identified as

only "Ester/Aromatic". If the Examiner is suggesting that the inventors as well as this attorney are lacking in fundamental honesty in the presentation of and reliance upon misleading data, this suggestion is, to say the least, misplaced as well as being insinuative of an unacceptably low standard of professional integrity in the members of two respected professions. Since the results in question were presented as comparative results, the inventors would not have changed the relevant experimental variables without a notice to that effect. Similarly, the attorneys charged with the preparation and prosecution of the patent application and this appeal would not knowingly rely on such data if they were not scientifically valid and reasonably probative of the point in issue.

3.4. In point of fact, the results obtained in Examples 11, 12, 16 and 18 all used the same "Ester/aromatic" co-base oil and all used it in the same amount. Similarly, the additive package "PCEO/DDI" (Passenger Car Engine Oil/Detergent Dispersant Inhibitor" package was just the same for all these Examples as was the amount in which it was present in the finished oils. So, the only experimental variable which was changed was the wax isomerate: Examples 11 and 16 used the wax isomerate identified as A-1 with the lower pour point of -66°C and Examples 12 and 18 used the wax isomerates identified as B-2 and B-1 with pour points of -40°C and -34°C, respectively. This being so, it is submitted that the comparative showing made is probative of the effect of the pour point of the wax isomerate base oils and of nothing else. There is just nothing, beyond the Examiner's unsupported speculation that some unspecified "other factors may have contributed to the improved results". The Examiner is not entitled to rely upon such rank and insubstantial speculation in assessing the probative value of a scientific work performed by skilled persons and presented in good faith in the patent application. To the extent that the rejection of Claim 10 is based upon such speculative reasoning, it must be reversed as being arbitrary, capricious and not supported by substantial evidence. *In re Lee*, above.

#### 4. Conclusion

The present invention has not been shown to be obvious under the standards of 35 USC 103(a) as asserted by the Examiner having regard to the findings of fact supported by substantial evidence and by the conclusions drawn from evidence of record. The rejections should therefore be withdrawn.

Respectfully submitted,



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